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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,602	06/26/2003	Robert Wieber	1001-117	5017

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EXAMINER

PATEL, KIRAN B

ART UNIT PAPER NUMBER

3612

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,602

Applicant(s)

WIEBER, ROBERT

Examiner

Kiran B. Patel

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,8,9,13 and 22-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Final Rejection

Election/Restriction

1. Applicant's election with traverse of group I, Species E, Fig 4, claims 1-13 is acknowledged.

Applicant canceled claims 2, 4, 5, 7, 10-12, 14-21.

Applicant added new claims 22-38.

Newly submitted claims 22-24, 27-38 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they include limitations which were not searched in before preparation of the first Office Action i.e. a roof panel; a side panel; etc.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22, 23, 24, and

27-38 withdrawn from consideration as being directed to a non-elected invention.

See 37 CFR 1.142(b) and MPEP § 821.03.

Further, claims 25-26, 28-29 are withdrawn by the Examiner from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species E. Species E does not contain the limitation of weld(s).

Further, claims 3, 6, 8, 9, 13 are withdrawn by the Examiner from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species E. Species E does not contain the limitation of a layer of primer and layer of paint.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Graber et al. (6,679,540) and in view of ordinary skill in the art.

Regarding claim 1, Graber et al. (6,679,540) discloses the invention as claimed to include a first member 50 having a first flange 58 providing a first attachment surface Fig 5; a second member 70 having a second flange providing a second attachment surface Fig 5, the second surface opposing the first surface, at least one of the first member and second member being a panel; and a structural adhesive material (col 5, lines 20-60) adhered to the first surface and the second surface.

However, Graber et al. (6,679,540) does not disclose the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of the an automotive e-coat and an automotive painting operation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made (specification page 10 lines 15-16 - "A number of epoxy-based structural reinforcing foams are known in the art and may be used to produce the structural foam adhesive material") to provide the structural adhesive material having a tensile strength of at least 12 MPa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat

activatable material that expands at a temperature encountered during at least one of an automotive e-coat and an automotive painting operation, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ416.

Response to Arguments

1. Applicant's arguments filed 7/21/04 have been fully considered but they are not persuasive.

In response to Applicant's argument "examiner in present application has withdrawn all claims having sealant material". Claims having the limitation sealant material have been withdrawn from further consideration because sealant material is not shown in elected species E.

Applicant's request for Examiner's approval for amending Fig 4 to include a primer layer 100 and a paint layer 102 is not approved. If Applicant insists on the approval it could be granted but the claims containing the limitation of a primer and

a paint layer are withdrawn from further consideration since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

In response to Applicant's argument "Office Action fails to establish a prima facie case of obviousness against the aforementioned claim". Applicant has clearly indicated on pages 2, 3, 6, 7-11 of the specification that there is a commercially available material(s) which can be used having a tensile strength of at least 12 Mpa which is applied with a mini-applicator including an extruder and the adhesive is formed from a heat activatable material that expands at a temperature encountered during at least one of an automotive e-coat and an automotive painting operation. It will not be practical to invest resources to develop material, which already have been developed and available commercially on the market.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Kiran B. Patel whose telephone number is 703-305-0254. The examiner can normally be reached on M-F from 8:00 to 5:00. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Kiran B. Patel, P.E.
Primary Examiner
Art Unit 3612
September 5, 2004